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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------|-------------|----------------------|--------------------------|------------------|
| 10/687,177 | 10/16/2003 | Naomi L. Nakao | G30-016 | 7585 |
| 7590 | 11/10/2005 | | EXAMINER | |
| R. Neil Sudol 714 Colorado Avenue Bridgeport, CT 06605-1601 | | | FLANAGAN, BEVERLY MEINDL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3739 | |

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

T-5th

| | | |
|------------------------------|---------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/687,177 | NAKAO, NAOMI L. |
| | Examiner Beverly M. Flanagan | Art Unit 3739 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-14, 16, 20, 21, 23-33, 37, 38 and 40-42 is/are rejected.
- 7) Claim(s) 15, 17-19, 22, 34-36, 39 and 43 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

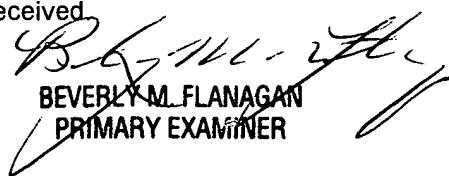
Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Preliminary Amendment

The preliminary amendment filed June 30, 2004 has been entered and made of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 9, 12-14, 20, 21, 23-25, 32, 33, 37, 38, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi (U.S. Patent No. 5,257,617).

In regard to claims 1-6, 8, 9, 12-14, 20, 23-25, 32, 33, 37, 38 and 41,

Takahashi teaches an endoscope with an insert part 10 formed from an elongated flexible tube and having a groove 11 formed along an outer surface of the insert part 10 that extends axially over the entire length thereof (see Figure 1 and col. 3, lines 7-11).

Figure 1 shows that the groove 11 has a longitudinally extending slot through its outer surface. A tubular member 21 of sheath 20 is removably fitted over the insert part 10 and serves to close the groove 11 (see Figures 1 and 3A). Channel tube 30 is removably disposed in the groove 11 and fastened to the tubular member 21 when the tubular member 21 is deployed over the endoscope (see figure 1). A distal end cover 22 is connected to the distal end of tubular member 21 and has an opening 31 for the

channel tube 30 to exit distally (see Figure 1). **In regard to claims 21 and 42**, Figures 1 and 3A of Takahashi show that the groove 11 has a mostly circular cross-section divided by the slot and is defined by a surface of the insert part 10 having a C-shaped cross-section.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (U.S. Patent No. 5,257,617).

In regard to claims 16 and 40, Takahashi is silent as to providing channel tube 30 with connectors for coupling the tube 30 with a source of irrigation or suction. However, Takahashi does disclose that the channel tube 30 defines a forceps channel (see col. 3, lines 58-60), and forceps channels are conventionally used in endoscopes for suction and irrigation in addition to be used to transport instruments to the distal end of the endoscope. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize the channel tube 30 of Takahashi for irrigation and suction and to provide a connector for coupling the channel tube 30 to a source of irrigation and suction for such purpose.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (U.S. Patent No. 5,257,617) in view of Adair (U.S. Patent No. 5,817,015).

In regard to claims 10 and 11, Takahashi teaches an endoscope 200 having a sheath 202 with a pull tab 218 for assisting in placing the sheath 202 over the endoscope (see col. 7, lines 34-60). Adair thus demonstrates that providing a sheath with a pull tab for assisting in its placement and removal is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the sheath of Takahashi with the pull tab 218 disclosed by Adair, as a means to assist in the placement and removal of the sheath 202.

Claims 7 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (U.S. Patent No. 5,257,617) in view of Nakao (U.S. Patent No. 6,929,601).

In regard to claims 7 and 26, Takahashi is silent as to the sheath being comprised of a strip wound about the insertion shaft and provided with an adhesive closure. However, Nakao discloses a similar sheath for an endoscope comprised of a sheet with an adhesive layer 188 (see col. 3, lines 39-67 and col. 4, lines 1-19). Nakao thus demonstrates an art recognized equivalent structure for covering and protecting an endoscope. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the sheath of Takahashi as a sheet with an

adhesive layer, in the manner disclosed by Nakao. **In regard to claims 27-29**, see the above rejection for claim 1.

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (U.S. Patent No. 5,257,617) in view of Nakao (U.S. Patent No. 6,929,601) and further in view of Adair (U.S. Patent No. 5,817,015).

In regard to claims 30 and 31, see the above rejection for claims 10 and 11.

Allowable Subject Matter

Claims 15, 17-19, 22, 34-36, 39 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art examples of endoscopes with channels on the exterior surface: Adair, U.S. Patent No. 5,643,175 and Opie, deceased, et al., U.S. Patent No. Re. 34,110.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571)

272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Beverly M. Flanagan
Primary Examiner
Art Unit 3739
